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Application No. 09/995,374  
Reply to Office Action of July 19, 2006

Docket No.: 65678-0045

**REMARKS**

Claims 1-19 are pending. Claims 1, 9, and 19 are independent claims. In the Office Action, claims 1-19 were rejected as allegedly anticipated by U.S. Patent No. 6,347,302 ("Joao"). Claim 1 is amended herein purely to address certain informalities. No other claims are amended or canceled herein, and no claims are added.

For at least the reasons set forth below, Applicants believe that their independent claims define patentable subject matter over Joao. Further, Applicants believe that there may be other reasons why their independent claims are patentable, and also that there are reasons why their dependent claims not explicitly addressed herein are separately patentable. Accordingly, Applicants reserve the right to address such additional reasons supporting the patentability of their claims, including dependent claims not explicitly addressed herein, in future papers.

**Argument**

As set forth below, Joao fails to teach or suggest numerous elements of Applicants' independent claims. Accordingly, for at least the reasons set forth below, Applicants respectfully submit that the rejection of claims 1-19 as allegedly anticipated by Joao must be withdrawn.

**A. "benchmarking information"**

Claim 1 recites "selecting a group of assets that are included in the pool of benchmarking information on a computer." Claims 9 and 19 each recite "a benchmarking information pool including said data value for said asset characteristic for said plurality of assets." The Office Action asserted that Joao discloses the foregoing limitations. In fact, Joao teaches no more than a database containing "data and/or information which is relevant to determining insurance policies and premiums related to the leasing and/or rental of" various kinds of vehicles and equipment. (Column 2: 22-28.) Thus, at least because Joao teaches that its data is used to determine insurance premiums, and this data is not taught or suggested to be used as benchmark data, Joao does not anticipate Applicants' claims.

In fact, much of the data disclosed by Joao appears to all relate to a single vehicle, and therefore clearly could not describe "a pool of benchmarking information." For example, Joao states that its data

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related to vehicle leases[] includes vehicle year, model, vehicle components and/or systems along with their repair costs, replacement costs, probability of damage, probability of post-warranty repairs necessitated by wear and tear, damage, malfunctioning components and/or systems and defects in materials, parts, components, systems and/or workmanship, average cost for repairs, historical leasing data including costs of typical repairs, average total excess wear and tear costs for the entire vehicle.

(Column 2: 32-42; see also column 6:6-16, 25-49.) Nowhere does Joao teach or suggest that this information is "a pool of benchmarking information." Other data disclosed by Joao relates to geographic factors or factors relating to particular individuals or business entities. (Column 2: 42-57; column 6: 16-24, 50-65.) Such data clearly does not pertain to any particular assets and therefore cannot read on "benchmarking information." In short, data disclosed by Joao includes only data used for calculating insurance premiums and not data included in "benchmarking information." Therefore, for at least this reason, Joao does not anticipate Applicants' claims.

Further, nowhere does Joao teach or suggest "selecting a group of assets" to be included in any pool of information, much less "benchmarking information on a computer." Instead, as noted above, Joao discloses considering information about a particular assets as well as factors that may influence an insurance premium for the asset. However, Joao does not teach or suggest "selecting a group of assets" that are used to determine an insurance premium. Accordingly, this is a further reason why Joao does not anticipate Applicants' claim 1.

At least for the foregoing reasons, claims 1, 9, and 19, as well as claims 2-8 and 2-9 depending therefrom, are allowable over Joao.

**B. "identifying . . . an asset characteristic"**

Claim 1 further recites "identifying on a computer an asset characteristic relating to an asset included in the pool of benchmarking information." However, although Joao discloses using information relating to an asset to calculate an insurance premium (e.g., column 9: 49-67), Joao does not appear to include any teaching or suggestion of "identifying . . . an asset characteristic relating to an asset." Instead, Joao appears to use available data without identifying any particular datum to calculate its insurance premium. Therefore, Joao does not

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teach or suggest "identifying on a computer an asset characteristic relating to an asset," much less that the asset characteristic is "included in the pool of benchmarking information."

For at least the foregoing independent reasons, claim 1, as well as claims 2-8 depending therefrom, are allowable over Joao.

**C. "a benchmark heuristic to generate a benchmark value"**

Claim 1 also recites "invoking a benchmark heuristic on a computer to generate a benchmark value relating to the identified asset characteristic." Claim 9 recites "a benchmark heuristic to generate a benchmark value for said asset characteristic from said benchmarking information pool." Claim in 19 recites "a benchmark heuristic to generate a plurality of benchmark values for said plurality of asset characteristics from said benchmarking information pool." However, as discussed above, Joao teaches at most calculating an insurance premium, which is plainly not the same as "invoking a benchmark heuristic." Further, Applicants' review of Joao finds no teaching or suggestion of "a benchmark value relating to the identified asset characteristic." Significantly, moreover, not only does Joao not teach or suggest an "identified asset characteristic" as discussed above, but Joao does not teach or suggest any benchmark value. In fact, as also discussed above, Joao at most teaches considering various factors concerning an asset that may be relevant in calculating an insurance premium. However, considering such factors is not the same as generating "a benchmark value" that relates to an "identified asset characteristic." Indeed, the factors disclosed in Joao are used to calculate an insurance premium that applies to an asset as a whole and that does not relate to any particular characteristic of the asset.

At least for the foregoing independent reasons, claims 1, 9, and 19, as well as claims 2-8 and 2-9 depending therefrom, are allowable over Joao.

**D. "a plurality of organizations"**

Claim 1 further recites "at least two organizations contribute to the pool of benchmarking information." Claim 9 recites "a plurality of organizations with relationships to said plurality of assets." Claim in 19 recites "a plurality of unrelated organizations with relationships to said plurality of assets." However, Joao appears to be wholly silent with respect to the source of data included in its database. In particular, Joao does not appear to identify any particular

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organization or organizations that contribute data used to calculate insurance premiums. Moreover, although Joao discloses information about "particular individuals and/or business entities" (e.g., column 6: 50-57), Joao does not teach or suggest that these "individuals and/or business entities" have any relationship to any particular assets. Accordingly, Joao does not teach or suggest the foregoing claim limitations.

At least for the foregoing independent reason, claims 1, 9, and 19, as well as claims 2-8 and 2-9 depending therefrom, are allowable over Joao.

### CONCLUSION

All pending claims are believed to be in condition for allowance over the prior art of record for at least the reasons set forth above. Applicants believe that no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65678-0045, from which the undersigned is authorized to draw.

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